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January 31, 2007

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Re:	Application No.:	09/414,290
	Confirmation No.:	3095
	Art Unit:	3692 (Examiner Timothy Harbeck)
	Appellants:	Enright, et al.
	Title:	Remote Viewing of ATM Transaction Records
	Docket No.:	D-1112 R1

Sir:

Please find enclosed a Reply Brief pursuant to 37 C.F.R. § 41.41 in response to the Examiner's Answer dated December 14, 2006 for filing in the above-referenced application.

No fee is deemed required. However, the Commissioner is authorized to charge any necessary fee associated with the filing of this Reply Brief and any other fee due to Deposit Account 09-0428.

Very truly yours,
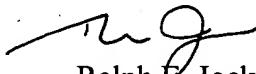
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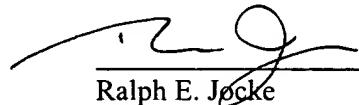
Ralph E. Jocke

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellants: **Enright, et al.**	)	
	)	
Application No.: **09/414,290**	)	Art Unit 3692
	)	
Confirmation No.: **3095**	)	
	)	Patent Examiner
Filed: **October 7, 1999**	)	Timothy Harbeck
	)	
Title: **Remote Viewing of ATM**	)	
Transaction Records	)	

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF OF APPELLANTS
PURSUANT TO 37 C.F.R. § 41.41

Sir:

The Appellants hereby submit their Reply Brief pursuant to 37 C.F.R. § 41.41 concerning

the above-referenced Application. This Reply Brief is in response to the Examiner's Answer

("Answer") dated December 14, 2006.

STATUS OF CLAIMS

Claims 1-43 are pending in the Application.

Claims rejected: 1-43

Claims allowed: none

Claims confirmed: none

Claims withdrawn: none

Claims objected to: none

Claims canceled: none

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The questions presented in this appeal are:

1).   Whether claims 1-9, 13, 17, 22, and 25-43 are unpatentable pursuant to 35 U.S.C.

§ 103(a) as obvious over Eisenberg (US 5,354,974) in view of the article *Java*

goes full circle, Bank Technology News, 12/1996 (hereafter "Java").

2).   Whether claims 10-11, 14-16, 18-21, and 23-24 are unpatentable pursuant to 35

U.S.C. § 103(a) as obvious over Eisenberg in view of Java and Hoang (US

6,014,183).

3).   Whether claim 12 is unpatentable pursuant to 35 U.S.C. § 103(a) as obvious over

Eisenberg in view of Java and Hoang and Wookey (US 6,023,507).

ARGUMENT

Appellants' Reply to the "Grounds of Rejection" Section of the Answer

The rejections set forth (at pages 4-30) in the Answer appear to be identical to the grounds previously presented (at pages 3-29) in the Office Action dated March 30, 2006, from which appeal was reinstated. Thus, Appellants respectfully submit that the rejections set forth in the Answer have already been fully addressed in Appellants' 2nd Supplemental Appeal Brief filed on September 25, 2006 (hereinafter "Appeal Brief"). Therefore, please note Appellants' previous arguments (in their Appeal Brief) regarding all the issues of record. Appellants' Appeal Brief (filed September 25, 2006) is incorporated herein by reference.

Appellants' Reply to the "Response to Argument" Section of the Answer

The Answer includes a "Response to Argument" section beginning on page 30. However, this section provides no new support for the rejections. Most of this section's "answer" consists of merely repeating the allegations already presented in the "Grounds of Rejection" section of the Answer. Thus, Appellants respectfully submit that the Office's "answer" has already been fully addressed in Appellants' Appeal Brief. The Office still has not provided any factual support for a *prima facie* conclusion of obviousness. Furthermore, the "Response to Argument" section of the Answer only addresses a portion of the many arguments made in support of patentability in the Appeal Brief.

Additionally, as discussed in more detail herein, the Office does not treat each claim as a whole. Rather, the Office dissects individual segments from a claim and then alleges that the segment is taught or suggested. The Answer ignores the relationships among the many segments

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that are specifically recited in the claims. As a result, the Answer procedurally fails to establish a *prima facie* case of obviousness.

For reasons of brevity, claim language may be referred to herein in a shortened version. For example, language such as "at least one" may be simply referred to as "a." Any generalized statement herein is not to limit any of the mentioned claims in any manner. Please refer to the specific claim for the exact claim language.

Claim 1

Review of the claim 1 subject matter

The apparatus of claim 1 is directed to a computer that is in operative connection with each of an automated banking machine, a camera (adjacent the machine), and a data store. The computer also includes a server. The computer/machine/camera/transaction/data store relationship enables the computer, responsive to the banking machine carrying out a transaction function, to include image data (corresponding to the camera signals) into the data store.

The apparatus of claim 1 is also directed to a user terminal including a browser. Both the user terminal and the server (which is in operative connection with the data store) are in operative connection with a communication network. This networked arrangement enables the user terminal to communicate (through the browser) with the server. The user terminal/browser/communication network/server/data store relationship enables the user terminal to output images corresponding to the (data store) image data through its output device.

As shown in more detail in the Appeal Brief, the relied upon evidence of record is missing the required relational links among an automated banking machine, camera, computer, server, transaction, image data, data store, communication network, user terminal, and browser.

<u>Even if the references were combined as alleged, the recited apparatus still wouldn't be produced</u>

For the many reasons previously discussed in the Appeal Brief, and the many more detailed hereinafter, it would not have been obvious to one having ordinary skill in the art to have modified Eisenberg with the teaching of Java in the manner alleged by the Office. Even if it were somehow possible (which it isn't) to modify Eisenberg with the teaching of Java as proposed by the Office, at best the result would merely be connection of Eisenberg's ATM to Java's marketing database to enable the marketing of Java's products to Eisenberg's ATM customers. Eisenberg's manner of storing security camera data would not be changed. Thus, even after modifying Eisenberg as proposed by the Office, Eisenberg would still lack many of the Appellants' recited features and relationships (including the admittedly absent arrangement comprising a user terminal with a browser specifically recited in claim 1).

As a result, even if the references were combined as alleged the Office still would not have established a *prima facie* case of obviousness. Nor would the proposed modification of Eisenberg have resulted in the recited invention of claim 1. The references, taken alone or in combination, would not teach or suggest the recited apparatus. Thus, Appellants respectfully submit that the rejection of claim 1 should be reversed.

Additional reasons why the rejection of claim 1 is legally improper follow.

<u>The rejection itself teaches against a *prima facie* case of obviousness</u>

As shown herein, the rejection itself provides evidence that the Office has not established a *prima facie* case of obviousness. The Office alleges that Eisenberg discloses a computer (10) in operative connection with an automated banking machine (5) (for a customer) and a camera (6). The Office further alleges that Eisenberg discloses (at col. 2, lines 1-3) a user terminal (used

by bank security people or the police). However, the Office (at Answer page 5) admits that Eisenberg does not teach or suggest a user terminal including a *browser*, especially a user terminal that can communicate with a server through a browser.

The Office (at Answer page 5) alleges that Java has an ATM including a browser, and that the ATM can access a server. The Office's reliance on Java is misguided, as the Office misinterprets claim 1. Claim 1 recites an apparatus that includes an automated banking machine *and* a user terminal. Claim 1 also recites that it is the user terminal which includes a browser. The rejection is incorrectly based on an ATM (not a user terminal) including the browser.

The Office has not shown prior art evidence of an apparatus that includes an automated banking machine *and* a user terminal, where the user terminal includes a browser. Thus, the Office has not established a *prima facie* case of obviousness.

The rejection is not legally valid because it is not based on evidence of record. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001). *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

Additional claim 1 features which neither Eisenberg nor Java teach or suggest:

Appellants respectfully submit that the Answer has failed to show that Eisenberg and Java also don't teach or suggest the following features and relationships recited in Applicants' claim 1:

1. the computer is operative to store *image* data (corresponding to the camera signals) in a data store (in operative connection with a server).

2. the computer is operative to store the image data in the data store *responsive to* the machine carrying out a transaction function.

3.   a user terminal (which includes a browser; which is in operative connection with the
communication network; and which communicates with the server) that can output
images corresponding to the (data store) image data through an output device (of the user
terminal).

A *prima facie* case of obviousness has not been established. Nor does the combination of
features disclosed in the references permit a *prima facie* case of obviousness to be established.

Appeal Brief Noted Features 1 and 2

The Appeal Brief (on pages 12-21) set forth arguments with regard to certain features that
the Eisenberg and Java references do not teach or suggest. Two of these features are set forth on
page 12 of the Appeal Brief. They are reproduced below.

Feature 1:   A computer/server that stores camera image data in a data store responsive to the
automated banking machine carrying out a transaction function.

Feature 2:   A user terminal browser that communicates with the server to access the image
data from the data store.

The Answer touches on some aspects of these two features, but still hasn't established a
prima facie case of obviousness.

Feature 1

The Answer (at the paragraph bridging pages 31-32) alleges that claim 1 does not recite a
computer that stores camera image data, but rather a computer/server that is "operative to"
include image data corresponding to camera signals in a data store. The Office appears to imply
that the "operative to" language is being treated only as intended use language, and is not given
any patentable weight.

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The Appellants respectfully disagree. The Office does not read claim 1 as a whole. The Office ignores that claim 1 recites that the computer is in operative connection with each of the automated banking machine, the camera, and the data store. The Office also ignores that this recited multi-facet linked relationship enables the *computer* "to include image data corresponding to the *camera* signals in the *data store* responsive to the *machine* carrying out at least one transaction function."

The Answer (on page 32) alleges with regard to Eisenberg that "the camera <u>records</u> the transaction <u>for later</u> apprehension and conviction, which indicates that the images are in fact stored" and "In order for the camera to record the transaction . . . a data store, in some form is *inherently* present." That is, the Office alleges that the camera (because it performs the recording) locally stores the data.

However, Eisenberg merely teaches that "the method includes enabling cameras set up at the automatic teller system to record the transaction either in an enhanced manner or with more cameras so that the identity of the thief can be more reliably obtained for later apprehension and conviction" (col. 1, lines 62-67). Eisenberg is silent about the particulars of his method. For example, where does Eisenberg specifically teach that the camera stores the recording in a data store in the camera, as alleged by the Office? The Office's new reliance on asserted "inherency" is taken as an admission that Eisenberg does not teach the features originally relied upon by the Office.

Furthermore, if in Eisenberg it is the camera (6) that (automatically) acts to store the data locally therein as a data store (as alleged by the Office), then how can the relied upon computer (10) in Eisenberg act to "include image data corresponding to the camera signals in the data

store" (claim 1)? It can't. That is, with the Office's allegation the relied upon computer (10) of Eisenberg can't constitute the recited computer.

Nor can the camera (6) constitute the recited computer. Eisenberg's camera (6) can't be both the recited camera and the recited computer. Again, the Office ignores that claim 1 recites that the *computer* is in operative connection with each of an automated banking machine, a *camera*, and a *data store*. In claim 1 the computer is distinguished from the camera.

Even if Eisenberg had a conventional security camera (6) with an analog videotape for storage, the videotape could not constitute the recited data store. Claim 1 recites "a server in operative connection with a data store." If Eisenberg's videotape constituted the recited data store as alleged, then how can an alleged server of the relied upon computer (10) be in operative connection with the videotape in a manner that allows the server to be communicated with to enable the output of images corresponding to the image data included in the data store? It can't. Eisenberg does not have a server in operative connection with an analog videotape (the Office's alleged data store). Nor has the Office explained how a server could access data stored in an analog videotape. Nor does the Office explain how such a server/videotape connection could structurally occur in Eisenberg. As discussed in the Appeal Brief, Eisenberg does not need or even mention a server. Thus, neither can Eisenberg's camera (6) constitute the recited data store nor can Eisenberg's computer (10) include the recited server.

The Answer (on page 33) alleges that "It thus *appears* that the computer is in *fact* in operative connection to a data store (the camera)." The Office admits that the alleged teaching is based on what "appears" to be a "fact," which is not a proper basis for rejection. Something either is or isn't a fact. The Office's need to rely on "appears" shows that the allegation is not

factual and is not supported by any actual teaching in the applied reference. Nevertheless, claim 1 recites "a server in operative connection with a data store." The Office's remarks are incorrectly based on a computer (without a server) in operative connection with only a data store. The Office ignores Appellants' recited computer/machine/camera/data store relationship, which enables the computer, responsive to the machine carrying out a transaction function, to include image data (corresponding to the camera signals) into the data store.

Furthermore, the Office can't rely on the same feature in a reference as teaching two different elements. Claim 1 distinguishes a data store from a camera, especially in a manner that enables the computer to be in operative connection with each of the camera and the data store. Where does Eisenberg teach (as alleged by the Office) that the relied upon computer (10) is in operative connection with a videotape (the alleged data store) in a camera? Eisenberg doesn't. Nor does Eisenberg teach that the relied upon computer (10) is in operative connection with each of the camera (6) *and* the camera"s videotape (the alleged data store). It follows that the Office's reliance on Eisenberg for the features alleged therein is without merit.

The Appellants argued in their Appeal Brief that Java doesn't store *image* data especially image data captured by a camera at an ATM, but instead is limited to storing marketing data in a marketing database. Thus, Java's (non-image) marketing data storage teaching is in no way linked to Eisenberg's security camera data. The Answer provides no prior art support for storing security image data as marketing data in a data store. As a result, the Office still has not refuted Appellants' remarks which show that the obviousness-based rejection of claim 1 is improper.

At best, the Answer states (on page 33) that because Eisenberg's cameras "record the transaction" the "examiner maintains that a recording of images of a transaction would be

encompassed within transaction data." The Appellants respectfully disagree. The rejection is based on pure speculation. Again, there is no prior art evidence of record for storing security camera data as marketing data in Java's (non-image) database.

Nor does the Office explain how Java's server could be structurally linked to Eisenberg's analog videotape (the alleged data store) to retrieve data therefrom. Again, claim 1 recites "a server in operative connection with a data store." As a result, even if it were somehow possible (which it isn't) to combine Eisenberg and Java as alleged, the combination still would not have produced the recited features and relationships.

Appellants respectfully submit that the clandestine reliance on McManus in the Answer (e.g., page 33) is legally improper, and should be disregarded. McManus isn't part of any pending rejection. Nor was McManus previously of record. Unless the Office first reopens prosecution to include McManus in a new rejection, then the Examiner is committing prejudicial error. Such error deprives the Appellants of their administrative due process rights (e.g., timely notice of the Examiner's position and opportunity for unhindered response thereto).

Moreover, the Examiner's discussions for the first time of McManus amount to a new ground of rejection in an Examiner's Answer. Such new ground of rejection requires approval from a Technology Center Director (MPEP § 1207.03 (I)). The Answer lacks the required approval.

Furthermore, if the McManus document was ever made part of a rejection, Appellants would challenge its alleged legitimacy. Why didn't the Office use a copy of the Buffalo News article (if it exists, as alleged)?

The Office's attempt to newly rely on McManus is taken as an explicit admission by the Office that the pending rejection, which is based solely on Eisenberg and Java, is insufficient for a showing of *prima facie* obviousness.

Even if McManus was applied in the rejection of claim 1, McManus still would not teach or suggest storing Eisenberg's security camera data as marketing data in Java's data store. McManus obtains a photograph of a customer's iris, gets a 256 byte code representing the photograph, and then compares the code with information already in a database. Neither the photograph nor the code is stored in a data store, especially as image data stored in a marketing data store.

Furthermore, McManus' code is for authorizing a customer to use the ATM. Such a user authorization process conventionally involves a comparison of user identification data (e.g., PIN). Such a user authorization process is conventionally carried out independently and separately from any transaction process. McManus has a conventional arrangement. Even McManus teaches that the authorization is performed before a *transaction* is allowed. The Office ignores the "responsive to" feature of claim 1. As a result, even if McManus were applied in the rejection, the Office still would not have established a *prima facie* case of obviousness.

The Answer (on page 34, first paragraph) further alleges that Eisenberg teaches storing image data in a data store *responsive to* a transaction. The Answer states that "the central computer acts to actuate the camera in response to the customer entering a specific PIN at the ATM" and "the camera would not be actuated (and the transaction not recorded) unless the customer first enters that specific PIN at the ATM." The Appellants respectfully disagree.

One skilled in the art would understand what constitutes a "transaction" with an automated banking machine. The Examiner improperly tries to broaden the term. The relied upon customer entry of an emergency PIN in Eisenberg does not constitute a transaction. First, claim 1 is directed to "responsive to the *machine* carrying out" the operation, not responsive to a *customer* action (as relied upon by the Office).

Second, as discussed in detail in the Appeal Brief, an emergency PIN at best causes a <u>simulation</u> of a normal transaction (to avoid alerting the thief that the ATM is *not* carrying out an actual transaction). One skilled in the art would recognize that Eisenberg's predetermined "simulation" steps do not constitute a "transaction." Even Eisenberg distinguishes a "transaction" from a "simulation" (abstract; col. 2, lines 11-28 and 40-45; col. 3, line 54 to col. 4, line 11; and col. 4, lines 40-45). The user has no control of the ATM, because the ATM is automatically controlled (col. 2, line 22; col. 4, lines 3 and 8). The outcome of Eisenberg's simulation is "predetermined" (col. 2, line 45; col. 4, line 44). The user has no bearing on the "predetermined" outcome. Furthermore, marked bills are dispensed (col. 2, lines 29-31). An ATM transaction doesn't dispense marked bills.

If Eisenberg's simulation were a transaction, then where is there any evidence that a user's account is assessed (as would be in a transaction) for any cash dispensed in the simulation? There isn't any evidence, because Eisenberg doesn't carry out a transaction. Even Eisenberg (by performing the predetermined "simulation" steps) teaches away from carrying out a transaction.

Furthermore, even if it were somehow possible (which it isn't) for Eisenberg's simulation to constitute a "transaction," the Office's own reasoning would show the rejection is improper.

For example, the Office alleges that Eisenberg's camera (6) is actuated to enable the transaction to be recorded. In order for this to be possible, the camera (6) has to be actuated *before* the transaction. That is, the "transaction" (so it can be recorded) would have to occur after the camera (6) was actuated. However, if the camera is actuated *before* the transaction, then how can the camera be actuated *responsive to* (after) the transaction? It can't. Note the timing relationship recited in claim 1 concerning the inclusion of the "image data" in the data store "responsive to" the "transaction." It follows that the Office has not established a *prima facie* case of obviousness.

The Answer (on page 34, first paragraph) further alleges that the Examiner "feels" it is not true that a police computer would determine whether the video was stored, because "it is actually the camera set up at the ATM that does the recording." Apparently, the Office is alleging that Eisenberg's camera (6) automatically causes the videotape to record. This is further evidence that Eisenberg's computer (10) is not "in operative connection with a data store" (i.e., the videotape) enabling it to "include image data corresponding to the camera signals in the data store" (claim 1).

Nevertheless, there is no legal ground for rejecting a claim based on how an Examiner "feels" on a specific day. The standards of examination are to "be the same throughout the Office" (MPEP 706(I)). Again, there is no evidence of record that the camera in Eisenberg stores the video therein as a dedicated data store, as alleged by the Office. Nor is there any evidence of record that the camera videotape permits server retrieval of video therefrom for output of the video at a user terminal, as apparently alleged by the Office.

The Answer (on page 34, first paragraph) further alleges that after the video is stored in the camera (6), then the video and audio can be transmitted via a modem to the police. However, there is no supporting basis for the allegation, merely speculation. As previously discussed, Eisenberg is silent about the particulars of his operational method. What specific teaching in Eisenberg prevents the sending of a live video feed (not previously stored video) from the camera (6) to the local police? There isn't any. The local police would benefit from the timeliness of the information provided by the live feed. Many other reasons in support of Eisenberg providing a live feed are discussed in the Appeal Brief. Such a live feed would further remove the relied upon computer (10) in Eisenberg from relation with the video. As a result, the computer (10) would be further distanced from the recited computer.

The Office has not established a *prima facie* case of obviousness, especially with regard to feature 1. Thus, the rejection of claim 1 should be reversed.

Feature 2

Feature 2 is directed to the recited user terminal. On Appeal Brief page 17 the Appellants had asked "Where do the references teach or suggest a user terminal using a browser to communicate with a server to access data store image data and to output images corresponding to the accessed image data through an output device, especially where the image data was produced from a camera adjacent an automated banking machine and the server stored the produced image data in the data store responsive to the machine carrying out a transaction function?"

The Answer (on page 34, last paragraph) replies that "Appellant has only claimed a user terminal . . . that is operative to output images." The Appellants respectfully disagree. As claim 1 shows, and as previously discussed, more than just a user terminal is recited. The Answer

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avoids the recited user terminal/browser/communication network/server/data store relationship, which enables the user terminal to output images corresponding to the (data store) image data through its output device.

The Answer (on page 35, lines 1-3) further replies that "if the prior art structure is capable of performing the intended use then it meets the claim." Appellants respectfully submit, and have shown, that the relied upon "prior art structure" of the references does not meet the "recited structure." Nor is the relied upon "prior art structure" capable of being used in the manner recited by Appellants.

The Answer (on page 35) indicates that Eisenberg is relied upon at col. 2, lines 1-3 to show "a user terminal including an output device in operative connection with the network." The relied upon section of Eisenberg simply reads: "Video and audio information can be transmitted via modem to bank security people or the police at the same time." Where is the recited "user terminal" in this relied upon section? Where in the relied upon section is the recited "user terminal . . . in operative connection with the network," which network is in operative connection with a server, which server is in operative connection with a data store, and where is the user terminal that can communicate with the server through a browser to output images? Where does the relied upon section mention a browser, network, server, or data store? The relied upon section does not teach or suggest the recited features and relationships. Even the Answer (on page 35) admits that "Eisenberg does not disclose a browser and a server-type system to distribute these images." This is because, one skilled in the art (such as Eisenberg) would understand that Eisenberg's system transmitting information via a modem does not entail a

browser or a server. As the relied upon section of Eisenberg does not teach the features alleged, the rejection is not legally valid.

The Answer (on page 35, first full paragraph) continues that "Java discloses *browsers in ATMs* that can access a massive database from a centralized server that ATMs (with browsers) can access." So? This allegation is immaterial to the claim 1 subject matter.

The Office misreads claim 1. First, the claim 1 apparatus comprises *both* an automated banking machine *and* a user terminal. As previously discussed, claim 1 also recites that *"the user terminal includes a browser."* That is, the user terminal (not the ATM) is recited as including the browser. Thus, the relied upon (ATM) browser can't be the recited user terminal browser.

Second, the rejection itself distinguishes an ATM (for a customer in Eisenberg) from a user terminal (used by the bank security people or the police in Eisenberg). Note that the rejection relies on Eisenberg for a separate teaching of an ATM (5) and a separate teaching of a user terminal (col. 2, lines 1-3).

Third, Java teaches that the mentioned "massive database" is a marketing database. Java's marketing database has no link whatsoever to (and is non analogous to) storage of ATM security camera video (like Eisenberg's video).

Fourth, even if Java had a browser in the ATM as alleged, there is no teaching or suggestion that the browser would have been used to retrieve/return (via a network and a server) security camera video of its ATM from a data store for display at its (same) ATM. Again, the relied upon (ATM) browser can't be the recited user terminal browser.

As shown, the references do not teach or suggest the recited features and relationships of the user terminal. As a result, the Office has not established a *prima facie* case of obviousness.

The Answer (on page 35, first full paragraph) continues with the further assertion that Java teaches that "Java applets residing on this central server will be distributed to consumers' PCs (i.e., user terminal)." The Office is silent as to how Java's consumer PCs can constitute user terminals with regard to Eisenberg's ATM and security camera. Nor has the Office explained why (non public) police crime video from Eisenberg's ATM camera would be distributed to the personal computers (PCs) of (public) customers. Again, Java's database is a *marketing* database. The fact that the data in Java's marketing database is to be used with a consumer's PC for "traditional retailing" (Java at page 2, line 33) teaches away from the marketing database storing any ATM security camera video. That is, Java's use of the marketing database with a consumer's PC teaches away from the rejection of claim 1.

The Answer (on page 35, last paragraph) tries to rebut Appellants' argument (on Appeal Brief page 17) that "One skilled in the art would not store images of ATM theft (which are immediately needed by the security people/police) on a marketing database." The Answer's only responses are that Eisenberg's "cameras record" and "The examiner simply does not buy the Appellant's arguments that 'recording' is not 'storing'." However, the Examiner misses the point of Appellants' argument. The point is that the alleged storage of video on Eisenberg's security camera videotape has nothing to do with Java's marketing-dedicated database. As discussed above, Java's marketing database to consumer PC relationship actually teaches away from storing Eisenberg's security camera videotape in Java's marketing database. With regard to Eisenberg and Java, one skilled in the art would recognize that their type of data, their storage format, and their level of data security are all non analogous. Nor does the alleged storing of security video on videotape have anything to do with Appellants' recited computer, data store,

server, network, browser, and user terminal relationships. As previously discussed, the references do not permit storing (via an automated banking machine transaction function, a server, and a data store) of security image data in a manner that enables its output (via a browser, a network, the server, and the data store) through a user terminal output device.

The Answer (on page 36, lines 1-4) states that it has already admitted that Eisenberg does not teach or suggest a browser, thus no rationale is provided for Appellants' argument that Eisenberg "teaches away" from a user terminal having a browser. However, Appellants respectfully submit that Eisenberg indeed "teaches away" from using a browser because Eisenberg doesn't need a browser, especially for any ATM security video. Which applied reference teaches or suggests using a browser with ATM security images? The correct answer is neither. Nor do the references teach or suggest using ATM security images with regard to a server, a data store, network, and a user terminal. The fact that Eisenberg is also so technologically outdated (as admitted by the Office), further teaches away from Eisenberg having been even considered by one skilled in the art with regard to the Appellants' recited invention.

Appellants respectfully submit that the Office fails to correctly ascertain the level of ordinary skill in the art at the time of the invention. The rejection is not based on facts gleaned only from the prior art. Rather, the rejection attempts to apply today's level of ordinary skill in the art. The Office's attempt at hindsight reconstruction of Appellants' claimed invention is legally impermissible and does not constitute a valid basis for a finding of obviousness.

Nor is there any evidence that Eisenberg could be structurally modified in the manner alleged by the Office. Such an attempt, if somehow even possible (which it isn't), would destroy the utility and operability of the specifically disclosed Eisenberg apparatus. Such an attempt

would render the reference inoperable for its intended and desired purpose. An obviousness

rejection cannot be based on attempting a modification of a reference if making the attempt

would result in destroying the utility or advantage of the device disclosed in the reference. *In re*

Fine, 5 USPQ2d 1598-99 (Fed. Cir. 1988).

The Office's attempt to modify Eisenberg would also destroy Eisenberg's ability to

function as Eisenberg requires. Therefore, the attempt is not enabling to one of ordinary skill in

the art. A rejection based on an attempted modification that clearly does not produce an enabled

form of what is specifically recited in the claim, is not a proper rejection. *In re Kumar*, Case No.

04-1074 Fed. Cir. August 15, 2005.

Appellants also respectfully submit that the clandestine reliance on Barthel and

Anonymous ("Digital tape storage predicted to grow astronomically") in the Answer (e.g., page

36) is legally improper, and should be disregarded. Barthel and Anonymous aren't part of any

pending rejection. Nor were Barthel and Anonymous previously of record. Unless the Office

first reopens prosecution to include Barthel and Anonymous in a new rejection, then the

Examiner is committing prejudicial error. Such error deprives the Appellants of their

administrative due process rights (e.g., timely notice of the Examiner's position and opportunity

for unhindered response thereto).

Moreover, the Examiner's discussions for the first time of Barthel and Anonymous

amount to a new ground of rejection in an Examiner's Answer. Such new ground of rejection

requires approval from a Technology Center Director (MPEP § 1207.03 (I)). The Answer lacks

the required approval.

If the Barthel document was ever made part of a rejection, Appellants would challenge its alleged legitimacy. Why didn't the Office use a copy of the *American Banker* article (if it exists, as alleged)? Why did the Office provide only the alleged abstract and not the full article? What are the drawbacks concerning digital storage that are alluded to in the document? The Answer gives the appearance that the Office is hiding critical evidence that is contrary to its position.

For similar reasons, the Appellants would also challenge the alleged legitimacy of the Anonymous document. Why didn't the Office use a copy of the *Security* publication article (if it exists, as alleged)? The Anonymous document also indicates that cost is a negative factor, and that a DDS tape would be used. Eisenberg already uses a tape, without the additional cost.

Furthermore, the Office's attempt to improperly rely on Barthel and Anonymous is taken as an explicit admission by the Office that the pending rejection, which is based solely Eisenberg and Java, is insufficient for a showing of *prima facie* obviousness.

Even if Barthel and Anonymous were applied in the rejection of claim 1, they still would not teach or suggest the recited structure and relationships. Barthel and Anonymous appear to refer to an analog recorder (VCR using a video tape) and a digital recorder. Both use local storage, just like Eisenberg. Whether data is stored in an analog or digital format in Eisenberg's camera would make no difference with regard to the subject matter of claim 1. Barthel and Anonymous would not teach or suggest the structure and relationships enabling data store storing (via an automated banking machine transaction function, a server, and a data store) of security image data in a manner that enables its output (via a browser, a network, the server, and the data store) through a user terminal output device. As a result, even if Barthel and Anonymous were

applied in the rejection, the previously discussed deficiencies of the rejection based on Eisenberg and Java would still remain.

Again, the Office has not established a *prima facie* case of obviousness, especially with regard to feature 2. Thus, the rejection of claim 1 should be reversed.

Claim 38

The Appeal Brief (on pages 33-35) set forth arguments with regard to other "features" (different from those regarding claim 1) that the Eisenberg and Java references do not teach or suggest with regard to claim 38. Two of these other "features" are set forth on page 33 of the Appeal Brief. The Appellants specifically argued that the references do not teach or suggest:

1.   A computer that, in response to operation of a selected ATM function device, stores (on a first date) camera image data in a networked data store; and

2.   A networked terminal (remotely located from the ATM, yet in operative connection with the data store) that can (on a second date) retrieve the stored image data and display the images.

The Office's "answer" mentions claim 38 (at page 36, second paragraph), but it does not address Appellants' many arguments with regard thereto. It follows that the Office has not rebutted Appellants' arguments which show that the claim 38 rejection is improper. The Office has not established a *prima facie* showing of obviousness. It remains that the references, taken alone or in combination, would not have produced an apparatus with the structural ability to capture human images at an ATM with a camera; store (on a first date) the ATM/human images in a networked data store responsive to operation of a selected function device of the ATM; and

receive (on a second date) the ATM/human images from the data store with a networked terminal (remotely located from the ATM) for display.

The rejection of claim 38 is also not valid because it is wrongly based on an *ATM* accessing a data store (paragraph bridging Answer pages 18-19), instead of being based on a *terminal* (which is remotely located from the ATM).

No additional "reply" by Appellants is deemed necessary with regard to claim 38. For the reasons already set forth in their Appeal Brief, Appellants respectfully submit that the rejection of claim 38 should be reversed.

Claim 41

The Appeal Brief (on pages 36-38) set forth arguments with regard to additional "features" (different from those regarding claims 1 and 38) that the Eisenberg and Java references do not teach or suggest with regard to claim 41. Two of these additional "features" are set forth on page 36 of the Appeal Brief. The Appellants specifically argued that the references do not teach or suggest:

1. A computer (including a network server and being in operative connection with an ATM) that causes image data related to the ATM to be stored (at a first time) in a data store responsive to the ATM carrying out a transaction function with one of its transaction function devices; and

2. A network user terminal (remotely located from the ATM) that communicates with the network server to output (at a second time) the stored image data.

The Office's "answer" mentions claim 41 (at page 36, second paragraph), but it does not address Appellants' many arguments with regard thereto. It follows that the Office has not rebutted Appellants' arguments which show that the claim 41 rejection is improper. The Office has not established a *prima facie* showing of obviousness. It remains that the references, taken alone or in combination, would not have produced an apparatus with the structural ability to store ATM image data in a server data store responsive to the ATM carrying out a transaction function with a transaction function device, and later access the stored image data with a network user terminal (being remotely located from the ATM) that can communicate with the server.

The rejection of claim 41 is also not valid because it is wrongly based on ATM/server/data store communication (Answer page 22, lines 5-7), instead of being based on user terminal/server/data store communication.

No additional "reply" by Appellants is deemed necessary with regard to claim 41. For the reasons already set forth in their Appeal Brief, Appellants respectfully submit that the rejection of claim 41 should be reversed.

Claim 10

Claim 10 depends from claim 8/1. The Answer admits (on page 24) that Eisenberg/Java do not teach or suggest a data store including both camera image data and motion detection instructions, nor using the stored motion detection instructions to include the image data in the data store.

The Answer (at the paragraph bridging pages 36-37) asserts that Hoang discloses storing output of a security camera at an ATM responsive to scene changes (col. 3, line 66 to col. 4, line

6). In other words, "responsive to changes in motion the images are stored." The Appellants respectfully disagree.

The Office does not read claim 10 as a whole. Claim 10 depends from claim 8/1 and is further directed to the computer (which includes a server, and is in operative connection with an automated banking machine, camera, and data store), responsive to motion detection instructions, including image data (which corresponds to camera signals) in the data store. Hoang's computer (12) in the relied upon Figure 1 does not correspond to the recited computer. Thus, Hoang can't alleviate the admitted deficiencies of Eisenberg/Java. Furthermore, as discussed in the Appeal Brief, Hoang is directed to scene selection. The Office has not established a *prima facie* showing of obviousness.

Claim 12

Claim 12 depends from claim 11/8/1. The Action admits (on page 30) that Eisenberg/Java/Hoang do not teach or suggest a computer with the ability to send an e-mail message through a network responsive to instructions. That is, none of Eisenberg, Java, or Hoang involves e-mail. The Answer asserts that with Wookey's teaching (at col. 6, line 61 to col. 7, line 8) it would have been obvious to modify Eisenberg/Java/Hoang so that an individual using Eisenberg's ATM (5) can send identified problems via an e-mail to the central computer (10). The Answer (on page 37) simply repeats that "Wookey discloses the email feature."

Wookey is non analogous to the alleged combination of Eisenberg/Java/Hoang. Wookey is non analogous to an automated banking machine, camera, and image data. Where does the prior art of record link e-mail with an individual at an automated banking machine, as alleged by the Office? Furthermore, as noted by Appellants in their Appeal Brief (on page 44), it would be

unreasonable to have an individual using Eisenberg's ATM (5) send an e-mail to the central computer (10), as alleged by the Office. There is no evidence of record that Eisenberg's central computer (10) could receive or reply to an e-mail, nor does it need any e-mail.

The rejection is based on attempted hindsight reconstruction of Appellants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. The Office has not established a *prima facie* case of obviousness. It would not have been obvious to have modified Eisenberg as alleged to have produced the recited apparatus.

For reasons already discussed, the clandestine reliance on Barthel and Anonymous (*"Digital tape storage predicted to grow astronomically"*) in the Answer is legally improper, and should be disregarded. Nor do Barthel or Anonymous relate to e-mail.

CONCLUSION

For sake of brevity and to avoid further repetition of the Appeal Brief, attention is again directed thereto for additional reasons as to why the references do not render obvious the appealed claims. More detailed remarks regarding all the issues of record, including support for the patentability of each claim, can be found in the Appeal Brief.

Each of Appellants' pending claims specifically recites features and relationships that are neither disclosed nor suggested in the applied prior art. Furthermore, the applied prior art is devoid of any teaching, suggestion, or motivation for combining features thereof to produce the recited invention. For these reasons it is respectfully submitted that all the pending claims are allowable.

Respectfully submitted,

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